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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,957	07/14/2003	Mitsushi Yamamoto	UNI79.013AUS	6418
20995 7590 01/04/2010 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614				
EXAMINER				
CHANG, VICTOR S				
ART UNIT		PAPER NUMBER		
1794				
NOTIFICATION DATE		DELIVERY MODE		
01/04/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com  
eOAPilot@kmob.com

# Office Action Summary

**Application No.**

10/618,957

**Applicant(s)**

YAMAMOTO ET AL.

**Examiner**

VICTOR S. CHANG

**Art Unit**

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 8, 10-17, 19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) 13, 16 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8, 10-12, 14, 15, 19 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB06)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ ~~Notes of Informal Patent Application~~
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Introduction***

1. In view of the pre-brief appeal conference decision, the previous Office action has been withdrawn. Claims 8, 10-12, 14, 15, 19 and 20 are active.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. In response, the grounds of rejection have been updated as set forth below. Rejections not maintained are withdrawn.

### ***Specification***

4. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: the specification throughout contains numerous words with incomplete spelling. For example, in page 7, bottom paragraph, the terms "surface" are misspelled as "surfa e" or "surfa", the term "protective" is misspelled as "prot tive", the term "function" is misspelled as "fun tion", the term "other" is misspelled as "ther", and the term "thickness" is misspelled as "thi kness", etc. Appropriate corrections of the spelling errors throughout the specification are required in the next reply to avoid being held as nonresponsive.

***Claim Rejections - 35 USC § 103***

5. Claims 8, 10-12, 14, 15, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sumi [US 6582789] in view of Masuda [US 20020064650A1].

Sumi's invention relates to a protective film. The film is treated by an antistatic agent on the surface of the surface protective film opposite to the surface in which the adhesive layer is formed [abstract]. Useful films include biaxially oriented polyethylene terephthalate (PET) film [col. 3, ll. 6 and 18]. The thickness of the adhesive layer is preferably 3 to 50 micrometers [col. 5, ll. 60]. Examples of adhesives include acrylic adhesive having 2-ethylhexyl acrylate as a main monomer, vinyl acetate as a comonomer and hydroxyethyl methacrylate as a functional group-containing monomer in a ratio of 7:2:1 [col. 15, ll. 60-63].

For claims 8, 10-12, 14, 15, 19 and 20, Sumi lacks a teaching to form the antistatic layer of polymers having pyrrolidinium rings as multiple repeating units in main chains. However, Masuda's invention relates to a polyester film for window application [abstract]. The film comprises at least one side thereof an antistatic coating. The antistatic coating has a specific surface resistance of not more than  $1.0 \times 10^{13} \Omega$ , and a haze of not more than 5.0% and a visible light transmittance of 3 to 70% (transparent) [0012]. Examples of the antistatic agents include polymers having a backbone containing repeating units of pyrrolidinium rings [0031]. Examples of useful polyesters include polyethylene terephthalate (PET), etc. [0017]. On the side opposite from the antistatic coating of the polyester film, an adhesive is applied for pasting the film on window glass [0044]. It would have been an obvious modification to one of ordinary skill in the art to modify the antistatic layer of Sumi with polymers having pyrrolidinium rings as multiple repeating units in main chains, as taught by Masuda, because the selection of a known material

based on its suitability for its intended use supported a *prima facie* obviousness determination.

See MPEP § 2144.07. Regarding the use limitations in the preamble, since statements of intended use do not serve to distinguish structure over the prior art, it has not been given any patentable weight. *In re Pearson*, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974).

Regarding the functional limitation “being configured to maintain transparency even after one-hour heat treatment at 150°C”, absent any evidence to the contrary, it is deemed to be inherent to the same structure and composition of the film as the claimed invention, which is rendered obvious by the collective teachings of prior art as set forth above.

6. Claims 8, 10-12, 14, 15 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 11-256116 [computer English translation] in view of Masuda [US 20020064650A1].

JP ‘116 relates to a transparent surface-protective film. The film comprises a highly transparent polyethylene terephthalate (PET) film, which is preferably biaxially oriented. An antistatic layer is provided on one side of the PET film, and an adhesive layer is provided on the opposite side [abstract]. The thickness of the adhesive layer is 3-100 micrometers [0040]. Useful adhesives include acrylic pressure sensitive adhesive [0035].

For claims 8, 10-12, 14, 15 and 20, JP ‘116 lacks a teaching to form the antistatic layer of polymers having pyrrolidinium rings as multiple repeating units in main chains. However, Masuda’s invention relates to a polyester film for window application [abstract]. The film comprises at least one side thereof an antistatic coating. The antistatic coating has a specific surface resistance of not more than  $1.0 \times 10^{13} \Omega$ , and a haze of not more than 5.0% and a visible light transmittance of 3 to 70% (transparent) [0012]. Examples of the antistatic agents include polymers having a backbone containing repeating units of pyrrolidinium rings [0031]. Examples

of useful polyesters include polyethylene terephthalate (PET), etc. [0017]. On the side opposite from the antistatic coating of the polyester film, an adhesive is applied for pasting the film on window glass [0044]. It would have been an obvious modification to one of ordinary skill in the art to modify the antistatic layer of JP '116 with polymers having pyrrolidinium rings as multiple repeating units in main chains, as taught by Masuda, because the selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination. See MPEP § 2144.07. Regarding the use limitations in the preamble, since statements of intended use do not serve to distinguish structure over the prior art, it has not been given any patentable weight. *In re Pearson*, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974). Regarding the functional limitation "being configured to maintain transparency even after one-hour heat treatment at 150°C", absent any evidence to the contrary, it is deemed to be inherent to the same structure and composition of the film as the claimed invention, which is rendered obvious by the collective teachings of prior art as set forth above.

7. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 11-256116 [computer English translation] in view of Masuda [US 20020064650A1] and Sumi [US 6582789].

The teachings of prior art are again relied upon as set forth above.

For claim 19, the prior art is silent about the amount of co-monomer in the acrylic adhesive. However, Sumi's invention relates to a protective film, and exemplifies a useful acrylic adhesive comprising 2-ethylhexyl acrylate as a main monomer, vinyl acetate as a comonomer and hydroxyethyl methacrylate as a functional group-containing monomer in a ratio of 7:2:1 [col. 15, ll. 60-63]. It would have been an obvious to one of ordinary skill in the art to

select a known acrylic adhesive composition of Sumi to make the protective film of JP '116, because the selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination. See MPEP § 2144.07.

### ***Response to Arguments***

8. Applicants' arguments directed to withdrawn grounds of rejections are moot.

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VICTOR S. CHANG whose telephone number is (571)272-1474. The examiner can normally be reached on 6:00 am - 4:00 pm, Tuesday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on 571-272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Victor S Chang/  
Primary Examiner, Art Unit 1794